

## Remarks

### I. Status and Nature of the Amendments

This application is a continuation of US Patent Application Serial No. 08/141,833, filed on August 28, 1998 (now pending), which application claims priority from Provisional Application No. 60/056,292 (filed September 3, 1997), Provisional Application No. 60/077,874 (filed March 13, 1998), and Provisional Application No. 60/090,834 (filed June 26, 1998). Claims 1-28 were pending at the time of the Examiner's action. Claims 9-12, 14-17, 25-28 have been cancelled.

New claims 29-34 have been presented, and claims 1 and 13 have been amended. Claims 29 and 30 parallel the structural recitations of compound claim 1 and pharmaceutical composition claim 13, respectively, but recite that the compound or pharmaceutical composition binds to the RANTES CCR5 receptor. Claims 31 and 32 parallel the recitations of claims 1 and 13, but recite that the encompassed variants possess from 1 to 20 single amino acid deletions, insertions or substitutions relative to SEQ ID NO:2. Claims 33 and 34 parallel the recitations of claims 31 and 32, but recite that the compound or pharmaceutical composition binds to the RANTES CCR5 receptor. Support for the recitation that the claimed variants possess at least 80% homology to recited SEQ ID NO:2, or possess from 1 to 20 single amino acid deletions, insertions or substitutions relative to such sequence can be found at page 4, lines 5-10. Support for the recitation that the claimed compounds or pharmaceutical composition inhibit HIV-1 R5 virus infection of PBMCs *in vitro* or bind to the RANTES CCR5 receptor can be found, *inter alia*, at page 6, lines 14-25, and in Examples 14 and 15. Additional support can be found throughout the specification. Thus, no new matter has been added by the requested amendments.

In light of the requested amendments, claims 1-8, 13, 18-24 and 29-34 are presently pending. Claims 2-3, 5-8, 18, 19 and 21-24 have, however, been withdrawn from present

consideration as drawn to non-elected species. Accordingly, only claims 1, 4, 13 and 20, and 29-34 are under consideration.

## **II. The Rejection Pursuant to 35 U.S.C. § 112, Second Paragraph**

Claims 1, 4, 13 and 20 have been rejected pursuant to 35 U.S.C. § 112, second paragraph as indefinite. Applicants respectfully traverse and request reconsideration.

Claims 1, 4, 13 and 20 have been rejected in light of their recitation regarding “variants.” Applicants respectfully traverse and request reconsideration. Applicants understand the Examiner’s rejection to reflect a concern that those of ordinary skill would not have an adequate metric to determine whether a compound that they might prepare would infringe the claims.

Applicants have amended the claims to recite that the claimed variants possess a functional attribute of the RANTES protein, and exhibit a degree of structural relationship with the recited sequence of RANTES 2-68. Applicants respectfully submit that those of ordinary skill would therefore, in light of the present specification, now fully appreciate the meaning and scope of the variants recited in Applicants’ claims. In this regard, Applicants respectfully draw the Examiner’s attention to the fact that the RANTES protein is a member of a large family of cytokines (please see page 1, lines 12-13 of the specification). As disclosed on page 2, lines 14-15, various derivatives of RANTES are disclosed in Wells *et al.* (PCT Publication No. WO96/17935), which is incorporated by reference into the application (please see page 39, lines 28-30 of the specification). Applicants respectfully submit that the requested amendment fully responds to the Examiner’s concerns. It is therefore submitted that the rejection of claims 1, 4, 13 and 20 as indefinite may be properly withdrawn.

Claims 13 and 20 have been rejected pursuant to 35 U.S.C. § 112, second paragraph as allegedly indefinite due to their recitation of “treatment.” Applicants have amended the claims to delete this term, and respectively submit that the amendment fully

responds to the Examiner's concerns, and that the rejection of claim 13 as indefinite may now be properly withdrawn.

### **III. The Rejection Pursuant to 35 U.S.C. § 112, First Paragraph**

Claims 1, 4, 13 and 20 have been rejected pursuant to 35 U.S.C. § 112, first paragraph as not being described in the specification in such a manner as to reasonably convey to those skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse and request reconsideration.

Claims 1, 4, 13 and 20 have been rejected in light of their recitation regarding "variants." Applicants respectfully traverse and request reconsideration in light of the amended claims. Applicants respectfully submit that the claims are now clearly supported by the written description provided in the specification (please see page 5, line 30 – page 6, line 27), and that the originally filed specification evidences to those of ordinary skill that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully submit that the rejection may be properly withdrawn.

### **IV. The Rejection for Double Patenting**

Claims 1, 4, 13 and 20 have been rejected under the judicially created doctrine of obviousness-type double patenting in light of claims 1-9 of U.S. Patent 6, 168,784. Applicants respectfully submit that in the absence of any indication of Allowable subject matter, it is premature to conclude that the claims of the present application are patentably indistinct from those of the '784 Patent. Applicants accordingly request that the Examiner reconsider the issue of double patenting upon finalization of the allowable subject matter of this application.

Applicants will, however, agree to file a terminal disclaimer terminally disclaiming such portion of the present application as would survive the expiration of the '748 Patent,

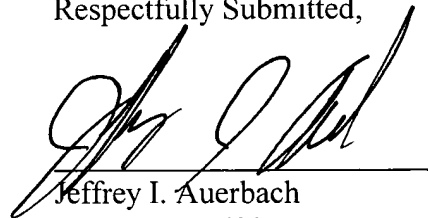
and to provide for common ownership, in the event that the Examiner ultimately concludes that the allowable subject matter of this application is patentably indistinct from those of the '784 Patent.

**V. Concluding Remarks**

Applicants respectfully submit that the present application is in condition for Allowance and Examination of the non-elected species, and earnestly solicit early notice of such favorable action. The Examiner is respectfully invited to contact the undersigned with respect to any issues regarding this application.

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Respectfully Submitted,

  
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